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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,179	06/29/2000	Yuan Chang	45185-CA/JPW/SHS	1263

7590

07/15/2003

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New York, NY 10036

EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

177

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,179

Applicant(s)

CHANG ET AL.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 44-48, 52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 44-48, 52 and 53 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 12, 2003 has been entered.

Claims 44-48, 52 and 53 are pending in the instant application.

Claims 44-48 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Claims 52 and 53 are drawn to the invention elected by original presentation; however, these claims are now drawn to multiple patentably distinct inventions, each defined by a unique SEQ ID NO. Therefore, a further restriction requirement is warranted and is communicated below.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 44-48, drawn to an antibody for a peptide that uniquely defines a herpesvirus associated with Kaposi's sarcoma, classified in class 530, subclass 387.1.

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2-37. Claims 52 and 53, drawn to a peptide that uniquely defines a herpesvirus associated with Kaposi's sarcoma, wherein the polypeptide is one of those encoded by at least a portion of one of the sequences set forth in SEQ ID NOS: 2-37, and a composition thereof, classified in class 530, subclass 300.

Applicant is informed that because this application is a Request for Continued Examination (RCE), invention 1 cannot be elected because the prosecution of the invention must continue in accordance with the originally elected invention, that being the isolated polypeptide. However, because the claims have never been cancelled, they are technically pending and must be included in the restriction requirement. Any indication of election of Group 1 will result in a non-responsiveness letter since RCE practice does not permit switching inventions. Applicant is required to cancel the non-elected claims.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1 and 2-37 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and effects, and are not disclosed as capable of being used together. Group 1 is directed to an antibody, which comprises a four chain molecule capable of recognizing a distinct polypeptide sequence in an immunogenic capacity, whereas Groups 2-37 represent polypeptides which do not have the capacity to specifically recognize polypeptide sequences immunogenically but rather have distinct structures which confer distinct biochemical

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functions. Because these molecules are structurally distinct and have different activities, the molecules have different functions and effects and are therefore patentably distinct.

Inventions 2-37 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have distinct functions and effects and are not disclosed as capable of being used together. Specifically, each sequence claimed as SEQ ID NO: 2-37 encodes a distinct polypeptide (where the sequence is a nucleotide sequence) or represents a distinct polypeptide with a particular amino acid sequence which confers a distinct polypeptide structure having a distinct biochemical activity. Because the molecules as claimed have distinct structures and associated biochemical activities, the molecules have different effects and functions and therefore patentable distinct.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the sequences listed in claim 52 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such sequences to be claimed in a single application. Under this policy, a single independent and distinct sequence will be examined in a single application.

Claim 52 specifically claims SEQ ID NOS: 2-37. The sequences are considered to be unrelated since each sequence claimed is structurally and functionally independent and distinct for the following reasons: each sequence comprises a distinct and specific sequence of biological subunits (in some cases amino acids, in some cases nucleotides) that confers a distinct property

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on each particular sequence because each amino acid sequence will have a distinct structure and function associated with said structure, and because each nucleotide sequence has a distinct function in that each encodes a distinct polypeptide structure with an associated function. Furthermore, a search of more than one (1) of the sequences claimed presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequences. In view of the foregoing, one (1) sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicant is required to elect one (1) sequence when electing Groups 2-37 as set forth above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, especially in instances where the classifications are the same, the non-patent literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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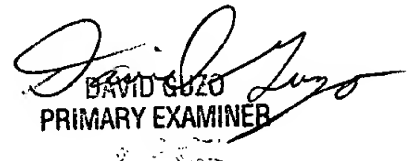
application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson  
July 10, 2003

  
DAVID GUZO  
PRIMARY EXAMINER